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[10191/3137]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES



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Re Application of: : Examiner: G. Bugg
Reiner MARCHTHALER :
: Art Unit: 2636
For: DEVICE FOR DETECTING A SEATING :
POSITION OF A PASSENGER IN A :
MOTOR VEHICLE :
: Confirmation No.: 5497
Filed: September 9, 2003 :
: Customer No.: 26646
Serial No.: 10/658,060 :
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APPEAL BRIEF TRANSMITTAL

SIR:

Transmitted herewith for filing in the above-identified patent application, please find
an Appeal Brief pursuant to 37 C.F.R. § 41.37, in triplicate.

Please charge the Appeal Brief fee of \$500.00, and any other fees that may be
required in connection with this communication to the deposit account of **Kenyon &
Kenyon**, deposit account number **11-0600**. A duplicate of this Transmittal is enclosed.

Respectfully submitted,

By: LO 18.Nu. 41,172

Dated: 4/13/06

By: 812
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[10191/3137]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re application of:
Reiner MARCHTHALER

For: DEVICE FOR DETECTING A
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Signature: *R. Hannon*

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

SIR:

On December 13, 2005, Appellant submitted a Notice of Appeal from the final rejection of claims 1-5 contained in the Final Office Action issued by the U.S. Patent and Trademark Office (the "PTO") on July 13, 2005, in the above-identified patent application. The notice of Appeal is believed to have been received by the United States Patent and Trademark Office on December 16, 2005.

In accordance with 37 C.F.R. § 41.37, this brief is submitted in support of the appeal of the final rejection of claims 1-5. For at least the reasons set forth below, the final rejection of claims 1-5 should be reversed.

1. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Robert Bosch GmbH, Postfach 30 02 20, 70442 Stuttgart, Federal Republic of Germany. Bosch is the assignee of the entire right, title, and interest in the present application.

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2. **RELATED APPEALS AND INTERFERENCES**

There are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellant or the assignee, Robert Bosch GmbH, "which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal."

3. **STATUS OF CLAIMS**

Appellant appeals from the final rejections of claims 1-5. Among the appealed claims, claim 1 is independent. Claims 2-5 depend from claim 1.

Claims 1 and 4 stand finally rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,748,473 ("Breed et al.").

Claims 2, 3, and 5 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Breed et al.

A copy of the appeal claims, *i.e.*, claims 1-5, is attached hereto in the Claims Appendix.

4. **STATUS OF AMENDMENTS**

Appellant has not filed a Response to the Final Rejection.

5. **SUMMARY OF THE CLAIMED SUBJECT MATTER**

The present invention relates to a device for detecting a seating position of a passenger in a seat of a motor vehicle. *Specification*, page 1, lines 9 to 11. Fig. 1 shows an example embodiment of the device. *Specification*, page 2, lines 15 to 16. The device includes a sensory system 1 that may detect a passenger 8 on a motor vehicle seat including a seat pad 5, a seat backrest 6, and a head rest 7. *Specification*, page 3, lines 13 to 17. The sensory system 1 may provide a signal indicative of the passenger's seating position in the seat to evaluation electronics 2, which may be able to determine the passenger's seating position. *Specification*, page 3, lines 15 to 18. The device further includes an arrangement, e.g., the evaluation electronics 2 and a display 9, for outputting an instruction to the passenger 8 for adjusting the seat. *Specification*, page 3, lines 19 to 24. The instruction is output as a function of the sensory system signal. *Specification*, page 3, lines 17 to 23.

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

A. Whether claims 1 and 4, which stand rejected under 35 U.S.C. § 102(b), are patentable over U.S. Patent 5,748,473 (“Breed et al.”).

B. Whether claims 2, 3, and 5, which stand rejected under 35 U.S.C. § 103(a), are patentable over Breed et al.

7. **ARGUMENTS**

A. **Rejection of Claims 1 and 4 Under 35 U.S.C. § 102(b)**

Claims 1 and 4 stand finally rejected under 35 U.S.C. § 102(b) as anticipated by Breed et al. It is respectfully submitted that Breed et al. do not anticipate either of claims 1 and 4 for at least the following reasons.

It is “well settled that the burden of establishing a *prima facie* case of anticipation resides with the [United States] Patent and Trademark Office.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Claim 4 relates to a device for detecting a seating position of a passenger in a seat of a motor vehicle and recites “an arrangement for outputting to the passenger at least one instruction for adjusting the seat as a function of the signal from the sensory system.” Breed et al. do not disclose or suggest outputting an instruction to a passenger for adjusting a seat. Instead, Breed et al. refer to an automatic adjustment of seat components as a function of a passenger’s height. Breed et al., column 6, lines 10 to 46. In the “Response to Arguments” section of the Final Office Action, the Examiner incorrectly asserts that the automatic adjustment of the seat in Breed et al. discloses an instruction output to the passenger. While the seat adjustment might be noticed by the passenger, it is not an instruction of any kind. Furthermore, nowhere do Breed et al. indicate that the seat adjustment is implemented in a manner so that it would be readily noticeable by the passenger. For example, it may be performed gradually so that the adjustment is not noticed. Further, claim 1 recites that the instruction is output “for

adjusting the seat.” Even if the seat adjustment in Breed et al. is performed in a manner that is readily noticeable by the passenger, the seat adjustment is not performed so as to instruct the passenger to adjust the seat, *i.e.*, it is not for adjusting the seat. To the contrary, what is noticed by the passenger (if noticed at all) is the automatic seat adjustment itself, during which all seat adjustment based on sensor signals is already performed.

Accordingly, Breed et al. do not disclose, or even suggest, an “an arrangement for outputting to the passenger at least one instruction for adjusting the seat as a function of the signal from the sensory system,” as recited in claim 1.

As for claim 4, which depends from and therefore includes all of the features recited in claim 1, it is respectfully submitted that Breed et al. do not anticipate this dependent claim 4 for the same reasons set forth above in support of the patentability of claim 1.

In view of all of the foregoing, reversal of this rejection of claims 1 and 4 is respectfully requested.

B. Rejection of Claims 2, 3, and 5 Under 35 U.S.C. § 103(a)

Claim 2

Claim 2 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Breed et al. It is respectfully submitted that Breed et al. do not render unpatentable claim 2 for at least the following reasons.

To establish a *prima facie* case of obviousness, the Office must demonstrate three criteria: (1) there must be some suggestion or motivation to one of ordinary skill in the art to modify a reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest each and every limitation in the claim under examination. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 2 depends from claim 1 and therefore includes all of the features recited in claim 1. It is therefore respectfully submitted that claim 2 is patentable over Breed et al. for at least the same reasons set forth above in support of the patentability of claim 1.

Reversal of this rejection of claim 2 is therefore respectfully requested.

Claim 3

Claim 3 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Breed et al. It is respectfully submitted that Breed et al. do not render unpatentable claim 3 for at least the following reasons.

As an initial matter, claim 3 ultimately depends from claim 1 and therefore includes all of the features recited in claim 1. It is therefore respectfully submitted that claim 3 is patentable over Breed et al. for at least the same reasons set forth above in support of the patentability of claim 1.

Furthermore, claim 3 recites “wherein the driving device is situated in a region of a head rest, a seat backrest and a seat pad.” The Examiner refers to support rods 165 and 116, servos 160 and 170, and motors 191-193 of Figure 1, and columns 1 and 2 of Breed et al. as allegedly disclosing or suggesting this feature. Breed et al. do not refer to an element 116. Further, none of the elements pointed out by the Examiner are situated in a region of a head rest.

For this additional reason, it is respectfully submitted that Breed et al. do not disclose or suggest all of the features of claim 3, and therefore do not render unpatentable claim 3.

In view of all of the foregoing, reversal of this rejection of claim 3 is respectfully requested.

Claim 5

Claim 5 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Breed et al. It is respectfully submitted that Breed et al. do not render unpatentable claim 5 for at least the following reasons.

As an initial matter, claim 5 depends from claim 1 and therefore includes all of the features recited in claim 1. It is therefore respectfully submitted that claim 5 is patentable over Breed et al. for at least the same reasons set forth above in support of the patentability of claim 1.

Furthermore, claim 5 recites “wherein the arrangement outputs the at least one instruction to the passenger at predefined points in time.” As set forth above in support of the patentability of claim 1, the automatic seat adjustment of Breed et al. do not disclose or suggest an arrangement that outputs an instruction to a passenger for adjusting a seat. Accordingly, whether or not the automatic seat adjustment at predefined points in time is disclosed or suggested in Breed et al. is irrelevant. Nowhere do Breed et al.

disclose or suggest an arrangement that outputs *an instruction to a passenger* for adjusting a seat *at predefined points in time*.

For this additional reason, it is respectfully submitted that Breed et al. do not disclose or suggest all of the features recited in claim 5, and therefore do not render unpatentable claim 5.

In view of all of the foregoing, reversal of this rejection of claim 3 is respectfully requested.

8. EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132. No other evidence has been entered by the Examiner or relied upon by Appellant in the appeal. An “Evidence Appendix” section is nevertheless attached hereto.

9. RELATED PROCEEDINGS APPENDIX

As indicated in Section 2, above, “[t]here are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellant or the assignee, Robert Bosch GmbH, ‘which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.’” As such, there no “decisions rendered by a court or the Board in any proceeding identified pursuant to [37 C.F.R. § 41.37(c)(1)(ii)]” to be submitted. A “Related Proceedings Appendix” section is nevertheless attached hereto.

10. CONCLUSION

For at least the reasons indicated above, Appellant respectfully submits that the art of record does not teach or suggest Appellant's invention as recited in the claims of the above-identified application. Accordingly, it is respectfully submitted that the invention recited in the claims of the present application is new, non-obvious and useful. Reversal of the Examiner's rejections of the claims is therefore respectfully requested.

Respectfully submitted,

KENYON & KENYON LLP

By: LG (D. No. 41,172)

Dated: 4/13/06

By: GC

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CLAIMS APPENDIX

1. A device for detecting a seating position of a passenger in a seat of a motor vehicle, comprising:
 - a sensory system for providing a signal indicative of the seating position of the passenger in the seat of the motor vehicle; and
 - an arrangement for outputting to the passenger at least one instruction for adjusting the seat as a function of the signal from the sensory system.
2. The device according to claim 1, further comprising:
 - a switch whose activation induces the device to trigger a driving device in the seat as a function of the signal.
3. The device according to claim 2, wherein the driving device is situated in a region of a head rest, a seat backrest and a seat pad.
4. The device according to claim 1, wherein the sensory system is one of an optical and an acoustical system.
5. The device according to claim 1, wherein the arrangement outputs the at least one instruction to the passenger at predefined points in time.



EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§1.130, 1.131, or 1.132. No other evidence has been entered by the Examiner or relied upon by Appellant in the appeal.



RELATED PROCEEDINGS APPENDIX

As indicated above in Section 2 of this Appeal Brief, “[t]here are no other prior or pending appeals, interferences or judicial proceedings known by the undersigned, or believed by the undersigned to be known to Appellant or the assignee, Robert Bosch GmbH, ‘which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.’” As such, there are no “decisions rendered by a court or the Board in any proceeding identified pursuant to [37 C.F.R. § 41.37(c)(1)(ii)]” to be submitted.